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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,936	09/10/2003	Peter Joel Lasensky	67175981.001107	5039
23562	7590	07/21/2009	EXAMINER	
BAKER & MCKENZIE LLP PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201			NGUYEN, THU HA T	
ART UNIT		PAPER NUMBER		2453
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/659,936	LASSENSKY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	THU HA T. NGUYEN	2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 April 2009.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15,20-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15, 20-31, 33-36 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

#### **DETAILED ACTION**

1. Claims 1-15, 20-31 and 33-36 are presented for examination.
2. Claims 16-19, 32 and 37-130 are cancelled without prejudice.
3. Claims 1, 3, 10, 12, 20, 22-23, and 34-35 are currently amended.

#### **Claim Objections**

4. Claim 1 is objected to because of the following informalities:
5. Claim 1 recited the limitations such as "one or more mobile device..."; "the mobile device..."; "a mobile device...". There is lack of antecedent basis for these limitations in this claim. Appropriate correction is required.

#### **Response to Arguments**

6. Applicant's arguments with respect to claims 1-15, 20-31 and 33-36 have been considered but are moot in view of the new ground(s) of rejection.

#### **Claim Rejections - 35 USC § 112**

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The

pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 1 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 1 and 22:

**"...associating a destination address associated with the data message with an identifier associated with the mobile device and with one of a plurality of intermediate address associated with the message authority, including or appending the intermediate address to the data**

**message...without the need for the mobile device to initiate a connection**

**with the message authority;"**

**"...initiating a native voice call from the mobile device **to the intermediate address associated with the message authority only, and to no other address;**"**

**"...the voice reply by reference to a combination of the mobile device identifier and the intermediate address"**

**"...the message comprising an identifier associated with a message authority that can be used to determine a reply path associated with the data message".**

Claims 1 and 22 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claim limitations. Especially, limitations of independent claims are not found supported by the specification of this instant application.

(2) Claims 1 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. An skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 1 and 22:

**"...associating a destination address associated with the data message with an identifier associated with the mobile device and with one of a plurality of intermediate address associated with the message authority, including or appending the intermediate address to the data message...without the need for the mobile device to initiate a connection with the message authority;"**

**"...initiating a native voice call from the mobile device to the intermediate address associated with the message authority only, and to no other address;"**

**"...the voice reply by reference to a combination of the mobile device identifier and the intermediate address"**

"...the message comprising an identifier associated with a message authority that can be used to determine a reply path associated with the data message".

Appropriate correction is required.

### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-12, 20-28, 30, and 33-36 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Wu et al.** (hereinafter Wu) U.S. Patent No. **6,813,489**, in view of **Koopmas et al.** (hereinafter Koopmas) U.S. Patent No. **7,024,460**.

11. As to claim 1, **Wu** teaches the invention as claimed, including a method of communicating, comprising:

a client device generating a data message comprising textual content intended to be received by one or more mobile devices (col. 1, line 59-col. 2, line 12, col. 4, lines 35-65, col. 5, lines 30-67);

the client device transmitting the data message to a message authority (col. 6, lines 43-61);

a message authority receiving the data message, associating a destination address associated with the data message with an identifier associated with the mobile device, and forwarding the data message to a mobile device, without the need for the mobile device to initiate a connection with the message authority (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61);

the mobile device receiving the data message and displaying the textual content (col. 5, lines 30-67);

the mobile device causing a voice reply to the data message to be generated by speaking into the mobile device using a transmit action, wherein generating the voice reply comprises initiating a native voice call from the mobile device to the message authority only, and to no other address (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61);

the mobile device associating the voice reply with the identifier that identifies the mobile device; the mobile device transmitting the voice reply to the message authority via the native voice call (col. 4, line 36-col. 5, line 67, col. 6, lines 42-61, col. 7, line 7-29); and the message authority, determining a

destination address for the voice reply by reference of the mobile device identifier (col. 6, lines 42-61, col. 7, line 7-29).

**Wu** does not explicitly teach associating a destination address with one of a plurality of intermediate addresses associated with the message authority, including or appending the intermediate address to the data message and the reference to a combination of the mobile device identifier and the intermediate address.

**Koopmas** teaches associating a destination address with one of a plurality of intermediate addresses associated with the message authority, including or appending the intermediate address to the data message and the reference to a combination of the mobile device identifier and the intermediate address (col. 9, line 8-col. 10, line 56, col. 15, line 19-45).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to modify the teachings of **Wu** to include the feature of associating destination address with intermediate address associated with the message authority and appending the intermediate address to the data message and the reference to a combination of the mobile device identifier and the intermediate address as disclosed by **Koopmas** because it would have provided an improved system for performing service-based compression of content, such as email message, within a network communications system.

12. As to claim 2, **Wu** teaches the invention as claimed in claim 1 further comprising the mobile device transmitting a spoken reply in response to the transmit action (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

13. As to claim 3, **Wu** teaches the invention as claimed in claim 2, further comprising a message authority receiving the spoken reply, and storing the spoken reply as a voice-message (col. 4, line 36-col. 5, line 7, col. 9, lines 40-65).

14. As to claim 4, **Wu** teaches the invention as claimed, including the method of claim 3, further comprising the message authority generating a data message indicating that a voice message is pending sending the data message to the client device (col. 5, line 9-29).

15. As to claim 5, **Wu** teaches the invention as claimed, including the method of claim 4, further comprising the message authority attaching the stored voice message or a copy of the stored voice message to the data message sent to each client device (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

16. As to claim 6, **Wu** teaches the invention as claimed, including the method of claim 4, further comprising the client device receiving the data

message and retrieving the voice message or a copy of the stored voice message (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

17. As to claim 7, **Wu** teaches the invention as claimed, including the method of claim 6, wherein receiving the data message comprises the client device using an email client to receive the data message (col. 4, line 35-65).

18. As to claim 8, **Wu** teaches the invention as claimed, including the method of claim 6, wherein retrieving the voice message comprises the client device receiving the data message and retrieving an attached voice message (col. 4, line 35-65).

19. As to claim 9, **Wu** teaches the invention as claimed, including the method of claim 6, wherein retrieving the voice message comprises the client device accessing the message authority to retrieve a copy of the voice message (col. 4, line 35-65).

20. As to claim 10, **Wu** teaches the invention as claimed, including the method of claim 1, wherein generating and transmitting the data message comprises using an email client to generate and transmit the data message (col. 5, line 9-29).

21. As to claim 11, **Wu** teaches the invention as claimed, including the method of claim 10, wherein the data message is an email message (col. 4, line 35-65).

22. As to claim 12, **Wu** teaches the invention as claimed, including the method of claim 1, wherein generating and transmitting the data message comprises using a web browser interfacing with a web-based application to generate and transmit the data message (col. 1, line 25-48, col. 3, line 17-39).

23. As to claim 20, **Wu** teaches the invention as claimed, including the method of claim 1, further comprising the message authority converting the spoken reply to a voice message and relaying the voice message to the determined destination address (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61).

24. As to claim 21, **Wu** teaches the invention as claimed, including the method of claim 1, further comprising associating both the mobile device identifier and the intermediate address with a communication pathway associated with the destination address (col. 4, line 26-65).

25. As to claim 22, **Wu** teaches the invention as claimed, including a mobile communication device, comprising:

a receiver configured to receive a data message, the data message comprising an identifier that can be used to determine a reply path associated with the data message (col. 1, line 59-col. 2, line 12, col. 4, lines 35-65, col. 5, lines 30-67, col. 6, lines 43-61);

a processor configured to parse the data message, extract the identifier, and determine the reply path from the identifier (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61); and

a transmit action mechanism, the communication device configured to receive a spoken reply to the data message in response to the initiation of a transmit action using the transmit action mechanism (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

**Wu** does not explicitly teach the data message comprises an identifier associated with a message authority.

**Koopmas** teaches the feature of data message comprises an identifier associated with a message authority (col. 9, line 8-col. 10, line 56, col. 15, line 19-45).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to modify the teachings of **Wu** to include the feature of data message comprises an identifier associated with a message authority as disclosed by **Koopmas** because it would have provided an improved system for performing service-based compression of content, such as email message, within a network communications system.

26. As to claim 23, **Wu** teaches the invention as claimed, including the communication device of claim 22, further comprising: a message generator configured to accept the spoken reply upon initiation of a transmit action, store the spoken reply as a voice message, create a data message, and attach the voice message or a copy of the voice message to the data message; and a transmitter configured to transmit the data message and attached voice message via the determined reply path (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61, col. 11, line 19-22).

27. As to claim 24, **Wu** teaches the invention as claimed, including the communication device of claim 23, wherein the message generator comprises a microphone and associated audio hardware configured to receive the spoken response from a user and convert the spoken response into a voice message for transmission using the transmitter (col. 2, line 60-col. 3, line 17, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61, col. 11, line 19-22).

28. As to claim 25, **Wu** teaches the invention as claimed, including the communication device of claim 23, wherein the transmitter is a wireless transmitter configured to transmit a wireless message (figure 1, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

29. As to claim 26, **Wu** teaches the invention as claimed, including the communication device of claim 22, further comprising a display, wherein the data

message further comprises textual content, and wherein the display is configured to display the textual content (col. 5, lines 30-67).

30. As to claim 27, **Wu** teaches the invention as claimed, including the communication device of claim 22, wherein the receiver is a wireless receiver configured to receive a wireless data message (figure 1, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

31. As to claim 28, **Wu** teaches the invention as claimed, including the communication device of claim 27, wherein the wireless data message comprises a two-way text message (figure 1, col. 4, line 36-col. 5, line 67, col. 6, lines 42-61).

32. As to claim 30, **Wu** teaches the invention as claimed, including the communication device of claim 27, wherein the wireless data message comprises an email message (col. 4, line 35-65).

33. As to claim 33, **Wu** teaches the invention as claimed, including the communication device of claim 22, further comprising a memory coupled with the processor, and wherein determining the reply path associated with the data message comprises accessing the memory and looking up the reply path using the identifier (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61).

34. As to claim 34, **Wu** teaches the invention as claimed, including the communication device of claim 22, wherein the reply path determined from the identifier is an intermediate reply path associated with a message authority, and wherein determining a final reply path associated with the data message comprises transmitting the spoken reply via the intermediate reply path to the message authority (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61).

35. As to claim 35, **Wu** teaches the invention as claimed, including the communication device of claim 34, wherein the processor is further configured to associate an identifier that can be used to identify a user of the communication device with the spoken reply (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61).

36. As to claim 36, **Wu** teaches the invention as claimed, including the communication device of claim 35, wherein the message authority is further configured to use the associated identifier and the intermediate reply path to determine a final reply path (col. 2, line 13-25, col. 5, line 9-29, col. 6, line 41-61).

37. Claims 13 and 29 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Wu et al.** (hereinafter Wu) U.S. Patent No. **6,813,489**, in view of **Koopmas et al.** (hereinafter Koopmas) U.S. Patent No. **7,024,460**, and further in view of **Guedalia et al.** (hereinafter Guedalia) U.S. Patent No. **6,907,112**.

38. As to claim 13, **Wu-Koopmas** teaches the invention as claimed, including the method of claim 1. However, **Wu-Koopmas** does not explicitly teach wherein the data message is an SMS message. **Guedalia** teaches the data message is an SMS message (col. 28, lines 40-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Wu-Koopmas** and **Guedalia** to include the feature of the data message is an SMS message because it would have provided an efficient system that provides data to the wireless data terminal.

39. Claim 29 has similar limitations as claim 13; therefore, they are rejected under the same rationale.

40. Claims 14-15 and 31 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Wu et al.** (hereinafter Wu) U.S. Patent No. **6,813,489**, in view of **Koopmas et al.** (hereinafter Koopmas) U.S. Patent No. **7,024,460**, and further in view of **Everhart** U.S. Patent No. **6,928,614**.

41. As to claim 14, **Wu-Koopmas** teaches the invention as claimed, including the method of claim 1. However, the combination of **Wu-Koopmas** does not explicitly teach wherein the transmit action comprises pressing and holding a button on the mobile device while speaking the reply. **Everhart** teaches the transmit action comprises pressing and holding a button on the

mobile device while speaking the reply (col. 1, line 42-col. 2, line 16, col. 3, line 32-col. 4, line 52). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Wu-Koopmas and Everhart** to include the feature of pressing and holding a button on the mobile device while speaking the reply because it would have provided a convenient and easy to use mobile office interface which integrates both voice and manual user inputs to provide simplicity and flexibility when controlling mobile office functions.

42. As to claim 15, **Wu-Koopmas** teaches the invention as claimed, including the method of claim 1. However, the combination of **Wu-Koopmas** does not explicitly teach wherein the transmit action comprises pressing and releasing a button on the mobile device before speaking, and pressing and releasing a button on the mobile device when finished speaking. **Everhart** teaches the transmit action comprises pressing and releasing a button on the mobile device before speaking, and pressing and releasing a button on the mobile device when finished speaking (col. 1, line 42-col. 2, line 16, col. 3, line 32-col. 4, line 52). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Wu-Koopmas and Everhart** to include the feature of pressing and releasing a button on the mobile device before speaking, and pressing and releasing a button on the mobile device when finished speaking because it would have provided a convenient and easy to use mobile office interface which integrates

both voice and manual user inputs to provide simplicity and flexibility when controlling mobile office functions.

43. As to claim 31, **Wu-Koopmas** teaches the invention as claimed, including the method of claim 22. However, **Wu-Koopmas** does not explicitly teach wherein the transmit action input is a push-to-talk input. **Everhart** teaches wherein the transmit action input is a push-to-talk input (col. 1, line 42-col. 2, line 16, col. 3, line 32-col. 4, line 52). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teachings of **Wu-Koopmas** and **Everhart** to include the feature the transmit action input is a push-to-talk input because it would have provided a convenient and easy to use mobile office interface which integrates both voice and manual user inputs to provide simplicity and flexibility when controlling mobile office functions.

### Conclusion

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (571) 272-3989. The examiner can normally be reached Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne, can be reached at (571) 272-4001.

The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/THUHA T. NGUYEN/

Primary Examiner, Art Unit 2453